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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,347	01/26/2004	Fumihiro Nakashige	248042US2	7110
22850	7590	11/16/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			CHEN, SOPHIA S	
			ART UNIT	PAPER NUMBER
			2852	

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/763,347

Applicant(s)

NAKASHIGE, FUMIHIRO

Examiner

Sophia S. Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 October 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.  
4a) Of the above claim(s) 8-39 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-5 is/are rejected.  
7) ☒ Claim(s) 6 and 7 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 26 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/26/04.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Election*

1. Applicant's election with traverse of Species I filed 10/13/05 is acknowledged.

The traverse is on the ground(s) for the following reasons: (a) the Office Action does not identify search classifications, it is believed that the claims of the present application would have to be searched in handful of sub-classes; (b) since electronic searching is commonly performed, a search may be made of a large number of, or theoretically all, subclasses without substantial additional effort; (c) a search and examination of the entire application would not place a serious burden on the Examiner, whereas it would be a serious burden on Applicant to prosecute and maintain separate applications.

The Examiner does not agree with the above arguments. First, MPEP § 808.01(a) states “--- Since the claims are directed to independent inventions, restriction is proper pursuant to 35 USC 121, and it not necessary to show a separate status in the art or separate classification (emphasis added)”. Second, it would require the Examiner to search in many different classes and subclasses based on so many different independent claims (10 of them). Third, the electronic searching is just an assisting tool for the Examiner. The primary searching is still based on the classification search. It adds substantial additional effort to the Examiner since both searching (electronic and classification) would be done in order to have a complete and thorough examination. Therefore, the Examiner strongly believes that it would place a serious burden on the Examiner if the Examiner has to search the entire application.

The requirement is still deemed proper and is therefore made **FINAL**.

***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: P1 (page 2, line 22, etc.), P1' (page 2, line 24), 44 (page 66, line 14, etc.), 48 (page 66, line 16, etc.), and  $\theta'$  (page 95, line 2). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 1 (Figure 1), 9 (Figure 2(a)), R' (Figure 2(a)), and 33 (Figure 13). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top

margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to because of the following informalities:

a. The sectional cross-hatching of reference numerals 3 (Figure 1), 27 (Figures 4, 5, and 16), and 28 (Figures 4, 10, 20, 23, 24, 27, 29, 31, 32, and 34) is incorrect.

b. Figure 10, "28B" between 28B and 27 should be labeled as "28A".

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

6. The disclosure is objected to because of the following informalities:

- a. Page 29, line 6, "claim 30" should not be in the disclosure because the claim numbering might be changed during the prosecution of the application.
- b. Page 44, line 21, "18A" and "18" should be "18B" and "19", respectively.
- c. Page 45, line 5, "18A" should be "18B".
- d. Page 46, line 10, "28" should be "18".
- e. Page 49, line 4, "29" should be "28".
- f. Page 51, line 21, "28B" should be "28A".
- g. Page 51, line 23, "28B" should be "28A".
- h. Page 55, line 10, "18A" should be "18B".
- i. Page 55, line 14, "18A" should be "18B".
- j. Page 72, line 8, "28" should be "25".
- k. Page 72, line 9, "28" should be "25".
- l. Page 73, line 10, "28" should be "18".
- m. Page 73, line 24, "28" should be "18".

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- n. Page 74, line 8, "27"" should be "27".
- o. Page 77, line 1, "18A" should be "28A".
- p. Page 93, line 25, "56" should be "56".

Appropriate correction is required.

***Claim Rejections – 35 U.S.C. §102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Sawaki et al. (US Pat. No. 4,937,613)

The patent discloses an image reader apparatus 4 comprising: an irradiation opening part for irradiating a lighting light to an outside part, which is formed at a light source (a cylinder shaped lamp) 3 (Figure 5); and an optical element 7A for attenuating a light amount so as to be permeated, which is provided between the irradiation opening part and a manuscript stand 2 (Figure 5).

***Claim Rejections – 35 U.S.C. §103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sawaki et al. in view of Kurita et al. (US Pat. No. 3,920,331)

Sawaki et al., as discussed above, differs from the instant claimed invention in not disclosing the cylinder shaped lamp is a Xenon lamp.

Kurita et al. discloses an image reader apparatus comprising a lamp 2 being a xenon lamp (column 3, lines 4-8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the xenon lamp as taught by Kurita et al. in place of the lamp of Sawaki et al. because of the same functionality for reading the document on the manuscript stand.

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sawaki et al. in view of Fellows (US Pat. No. 6,078,042).

Sawaki et al., as discussed above, differs from the instant claimed invention in not disclosing the optical element is formed by an ND filter having a surface to which a light absorbing process is applied.

Fellows discloses an ND filter 23 having a surface to which a light absorbing process is applied (column 5, lines 23-36).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the ND filter as taught by Fellows in place of the optical element (an infrared rays reflection filter) because of the same functionality for attenuating a beam of radiation.



12. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al. (US Pat. No. 6,369,875 B1) in view of Sawaki et al.

Ito et al. discloses an image reader apparatus 10 comprising an irradiation opening part for irradiating a lighting light to an outside part, which is formed at the light source (a cylinder shaped lamp) 11b (Figure 3); the cylinder shaped lamp 11b is a Xenon lamp (column 4, lines 10-13); and the cylinder shaped lamp 11b is moved in a sub scanning direction A perpendicular to a main scanning direction in which the cylinder shaped lamp 11b extends, so that the manuscript surface of the manuscript (original) is read (column 4, lines 15-18; Figures 2 and 3).

Ito et al. differs from the instant claimed invention in not disclosing an optical element for attenuating a light amount so as to be permeated, which is provided between the irradiation opening part and the manuscript stand 21.

Sawaki et al. discloses an optical element 7A for attenuating a light amount so as to be permeated, which is provided between the irradiation opening part and the manuscript stand 2 (Figure 5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the optical element as taught by Sawaki et al. to the image reader apparatus of Ito et al. so that the thermal deterioration of the original due to the infrared rays can be obviated (Sawaki et al.; column 5, lines 6-8).

***Allowable Subject Matter***

13. Claims 6 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Other Prior Art***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Taira (US Pat. No. 5,873,308) discloses an image reader apparatus comprising an irradiation opening part and an optical element (a lens).

Nakamura (JP 01-224742 A) discloses an image reader apparatus comprising an irradiation opening part and an optical element (an infrared absorbing filter).


***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sophia S. Chen whose telephone number is (571) 272-2133. The examiner can normally be reached on M-F (7:00-3:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Arthur Grimley can be reached on (571) 272-2136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sophia S. Chen  
Primary Examiner  
Art Unit 2852

Ssc  
November 14, 2005